

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION**

Applicant(s): Sanjay Patel

Serial No: 10/716,843

Group Art Unit: 1171

Filed: November 19, 2003

Examiner: Ana Lucrecia Woodward

Atty. Docket No.: S1177-20047

Confirmation No.: 7093

For: POLYAMIDE-AMIC ACID COATING FORMULATIONS AND PROCESSES

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

In response to the Office Action dated August 14, 2006, favorable reconsideration is requested in view of the following remarks. A Notice of Appeal in compliance with 37 CFR 41.31 is being filed concurrently herewith. Claims 1, 4-7, 14-17 and 24 are pending.

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

The pending claims, 1, 2, 4-7, 14-20 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,479,581 (Ireland et al.). This rejection was set forth in the Office Action of August 14, 2006. Other rejections were also set forth, under 35 USC 112 and as regards the '808 and '840 US patents. These other rejections were responded to in Applicant's Amendment of October 30, 2006 and, in the Advisory Action of November 8, 2006, were stated as having been overcome.

Applicant, in the Amendment of October 30, 2006, also presented arguments regarding Ireland et al. Specifically, Applicant argued that there was a difference between sizing applications (Ireland et al.) and coating applications (the present application). In the Advisory Action of November 8, 2006, the Examiner rejected Applicant's distinction between sizing applications and coating applications.

On December 6, 2006, in a response to Advisory Action, Applicant presented further arguments that the distinction between sizing applications and coating applications was proper. However, in the Advisory Action of December 27, 2006, the Examiner again rejected the distinction between sizing and coating applications. Again, this was the only reason stated for the application not being in condition for allowance.

Applicant's Argument in its Response to Advisory Action of December 6, 2006

In that Response, Applicant pointed out that even the reference cited by the Examiner, Ireland et al., makes a clear distinction between sizing applications and coating applications.

Applicant argued essentially as follows:

Ireland et al makes a clear distinction between coating compositions and sizing compositions:

Although useful in providing molded articles, particularly where filled resin compositions are employed, this method finds little use in coating **and** sizing applications because of the low melt flow and intractability of the resin. (Ireland et al, col. 2, lines 5-8, emphasis added here).

The use of the word “and” unambiguously conveys the idea that Ireland et al. intended coating applications to be distinct from sizing applications. Ireland et al. makes a similar distinction later:

When applied as a sizing **or** coating, the coated **or** sized article will then be dried to provide an adherent coating or film comprising polyamide comprising polyamide-amic acid. (Ireland et al, col. 10, lines 55-58, emphasis added here.)

Here the use of the word “or” unambiguously conveys the idea that Ireland et al. intended coating applications to be distinct from sizing applications.

The distinction is further supported by the fact that Ireland et al. discusses coating applications (col. 9, line 33-Col. 10, line 14) separately from sizing applications (Col. 10, lines 23-54). (Compare, for example, Col, 9, lines 33-35 to Col. 10, lines 22-24).

The Examiner's remarks in the Advisory Action of December 27, 2006

The Examiner stated that the term "coating" of the present claims, given its broadest reasonable interpretation, reads on the coating and sizing compositions of the prior art. Although not stated, it appears that the Examiner was following the guidelines in MPEP 2111. Nevertheless, the Examiner has not taken into account another guideline set forth in MPEP 2111.

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. MPEP 2111 citing *In re Cortright*, 165 F. 3d 1353, 1359, 49 USPQ 1464, 1468 (Fed. Cir. 1999). In *Cortright*, the Federal Circuit held that the construction of a claim term needed to be consistent with applicant's disclosure (the specification) and the disclosure of three patents from analogous arts. In the present case, Applicant's specification (and claims) only refer to coating compositions, not sizing compositions. Therefore Applicant's disclosure is in no way inconsistent with making a distinction between coating and sizing applications. Furthermore, in the present case, a patent not merely from an analogous art, but from *the identical art*, makes a clear distinction between sizing applications and coating applications.

In view of the foregoing, Ireland neither anticipates nor makes obvious either (1) Applicant's coating compositions (Claims 1 2, 4-7, 14-17); or (2) coatings made therefrom (Claim 24).

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Pre-appeal Brief re Office Action of August 14, 2006

Allowance of the application is therefore requested.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

February 12, 2007

Please charge or credit our
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By Allan H. Fried

Allan H. Fried
Registration No. 31,253

Customer No. 03000
(215) 567-2010

Attorneys for Applicants

Doc Code: AP.PRE.REQ

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) S1177/20047	
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	First Named Inventor Sanjay Patel		
	Art Unit 1171	Examiner Woodward, A.L.	
	Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.		
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. 31,253 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
		Signature Allan H. Fried Typed or printed name 215-567-2010 Telephone number FEB. 12, 2007 Date	
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